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Application No. 10/674,408  
Attorney Docket No. 06478.1446-01



PATENT  
Customer No. 22,852  
Attorney Docket No. 06478.1446-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Juergen Roemisch et al.

Application No.: 10/674,408

Filed: October 1, 2003

For: PROCESS FOR THE  
PREPARATION IN PURE FORM  
OF THE PROTEASE ACTIVATING  
BLOOD CLOTting FACTOR VII,  
ITS PROENZYME OR A MIXTURE  
OF BOTH PROTEINS BY MEANS  
OF CHROMATOGRAPHY

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) Group Art Unit: 1653  
)  
) Examiner: Samuel W. Liu  
)  
)  
) Confirmation No.: 5124  
)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

In a restriction requirement dated March 25, 2005, the Office first required restriction under 35 U.S.C. § 121 between the compositions of Group I (claims 9 and 16) and the methods of Groups II-IV (claims 10-15), all of which depend from claim 9 of Group I. Applicants provisionally elect, with traverse, to prosecute Group I, claims 9 and 16.

Second, the Office required Applicants to select a "single disclosed protein." Applicants further elect, with traverse, the "pure form of the protease activating blood clotting factor VII."

Third, upon election of Group I, the Office also required selection of a protein stabilizer for searching purposes. Applicants provisionally elect, with traverse, option (a), "complexing agents of divalent ions."

Applicants traverse all of these restriction requirements for the following reasons. First of all, with regard to the restriction to the "single disclosed protein," Applicants note that the Office's restriction requirement is inconsistent with Office's examination of the parent Patent No. 6,670,455 B1, the related Patent No. 6,677,440 B1 and the related Application No. 10/701,671. Applicants were not asked to restrict any of those prior inventions to any "single disclosed protein" despite the fact that they also recite a "pure form of the protease activating blood clotting factor VII, pure form of a proenzyme of the protease, or mixture of both the pure form of the protease and the pure form of the proenzyme." Moreover, because each of those earlier applications has already been searched and examined substantively, Applicants submit that there is no undue burden in joining all of the proteins in this application. For those reasons alone, Applicants request the withdrawal of this part of the restriction requirement.

Applicants traverse all of the restriction requirements as well because, according to M.P.E.P. § 803, "[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (M.P.E.P. § 803, emphasis added.) That is clearly the case here, as the Office has previously searched and issued process claims reciting all of the listed proteins, including all of the listed protein stabilizers as well. (See claims 1 and 10 of parent Patent No. 6,670,455 B1.) In any case, M.P.E.P. § 803.02 also directs the Office to extend a search of a list of species to

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a representative number of the species once the elected species is found free of the prior art. Applicants respectfully submit that this policy should apply to this application in order to avoid unnecessary delay to Applicants and duplicative examination by the Office.

Finally, all of Groups II-IV may be rejoined to Group I because they all depend from claim 9 of Group I. As the Office acknowledges at page 4 of the Office Action, process claims that depend from patentable product claims may be re-joined to an application as a matter of right under the policy of M.P.E.P. § 821.04.

In summary, Applicants request the Office to withdraw this restriction requirement and to join all of the pending claims for examination purposes.

This response is accompanied by a Petition for a Three-Month Extension of Time and the extension of time fee. Please grant any extensions of time required to enter this response and charge any required fees not found herewith to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 25, 2005

By: Elizabeth A. Doherty  
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